UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,241	07/18/2003	Steven E. Koenck	14410US02	3123

23446	7590	09/20/2006

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EXAMINER
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ART UNIT	PAPER NUMBER
2618	

DATE MAILED: 09/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	10/622,241	KOENCK ET AL.
	Examiner	Art Unit	
	MINH D. DAO	2618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *21-67* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *21-67* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____ .

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ .

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____ .

DETAILED ACTION

Priority

The later-filed application must be an application for a patent for an invention

which is also disclosed in the prior application (the parent or original nonprovisional

application or provisional application). The disclosure of the invention in the parent

application and in the later-filed application must be sufficient to comply with the

requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v.*

Performance Contracting, Inc., 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 09/597719 fails to

provide adequate support or enablement in the manner provided by the first paragraph

of 35 U.S.C. 112 for one or more claims of this application. Accordingly, claims 21-67

are not entitled to the benefit of the prior application.

Double Patenting

1.   The nonstatutory double patenting rejection is based on a judicially created
doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the
unjustified or improper timewise extension of the "right to exclude" granted by a patent
and to prevent possible harassment by multiple assignees.   A nonstatutory
obviousness-type double patenting rejection is appropriate where the conflicting claims
are not identical, but at least one examined application claim is not patentably distinct
from the reference claim(s) because the examined application claim is either anticipated
by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140
F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29
USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.

1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a

terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with

37 CFR 3.73(b).

2.   Claims 21-47 are rejected on the ground of nonstatutory obviousness-type

double patenting as being unpatentable over claims 1-19 of U.S. Patent No. 7,080,788.

Although the conflicting claims are not identical, they are not patentably distinct from

each other because the limitations of claims 21-47 of the present application are broad

enough to be encompassed by the limitations of claims 1-19 of US Patent 7,080,788

and as such it would have been obvious to one of ordinary skill in the art to implement

the claims of the present application using the claims of US Patent 7,080,788 in order to

implement such method and system as claimed in the present application.

3.   Claims 48-67 are rejected on the ground of nonstatutory obviousness-type

double patenting as being unpatentable over claims 1-19 of U.S. Patent No. 6,014,705.

Although the conflicting claims are not identical, they are not patentably distinct from

each other because the limitations of claims 48-67 of the present application are broad

enough to be encompassed by the limitations of claims 1-19 of US Patent 6,014,705

and as such it would have been obvious to one of ordinary skill in the art to implement

the claims of the present application using the claims of US Patent 6,014,705 in order to

implement such method and system as claimed in the present application.

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5.   Claims 21-67 are rejected under 35 U.S.C. 102(e) as being anticipated by

Dowling (US 2006/0195551 A1).

Regarding claim 21, Dowling teaches a base module for use in a portable terminal

utilizing a communication protocol stack having higher and lower layers, the portable

terminal also comprising a communication module having a wireless transceiver and

adapted to perform the functionality of the lower layers of the communication protocol

stack , the base module comprising:

a base memory adapted to store the higher layers of the communication protocol stack

(see figs. 2-5; sections [0016,0046,0057]); and a base processor adapted to cooperate

with the communication module to effect wireless communication by the communication

module, the base processor being adapted to perform the functionality of the higher layers of the communication protocol stack stored in the base memory (see figs. 2-5; sections [0016,0046,0057,0042-0044]).

Regarding claim 22, Dowling teaches the base module of claim 21 wherein the base processor's performance of the functionality of the higher layers of the communication protocol stack enables the base processor to cooperate with a communication module supporting substantially any type of wireless transceiver to effect wireless communication by the communication module (see figs. 2-5; sections [0031,0032, 0046,0057]).

Regarding claim 23, Dowling teaches the base module of claim 21 wherein the base module is configured to receive the communication module in an assembled position which communicatively couples the base processor and a module processor of the communication module (see figs. 2-4; sections [0037-0051]).

Regarding claim 24, Dowling teaches the base module of claim 23 further comprising: a base connector that is communicatively coupled to the base processor and that matingly engages a module connector disposed on the communication module upon receipt of the communication module into the base module in the assembled position (see figs. 2-4; sections [0037-0051]).

Regarding claim 25, Dowling teaches the base module of claim 21 wherein the higher layers of the communication protocol stack comprise power saving functionality (see section [0079]).

Regarding claim 27, Dowling teaches the base module of claim 21 wherein the higher layers of the communication protocol stack stored by the base memory and performed by the base processor comprise a sessions layer (see section [0059]).

Regarding claim 28, Dowling teaches the base module of claim 21 wherein the higher layers of the communication protocol stack stored by the base memory and performed by the base processor comprise a transport layer (see section [0059]).

Regarding claim 29, Dowling teaches the base module of claim 21 wherein the higher layers of the communication protocol stack stored by the base memory and performed by the base processor comprise a network layer (see fig. 3).

Regarding claim 30, Dowling teaches the base module of claim 21 wherein the base processor does not perform at least one lower layer function of the communication protocol stack, instead allowing the communication module to perform said at least one lower layer function of the communication protocol stack (see section [0016]).

Regarding claim 31, Dowling teaches the base module of claim 30 wherein the base processor does not perform the functionality of a physical layer of the communication protocol stack, instead allowing the communication module to perform the functionality of the physical layer (see fig. 3; section [0042]).

Regarding claim 32, Dowling teaches the base module of claim 30 wherein the base processor does not perform the functionality of a data link layer of the communication protocol stack, instead allowing the communication module to perform the functionality of the data link layer (see fig. 3; section [0055]).

Regarding claim 33, Dowling teaches the base module of claim 21 wherein the base memory is adapted to store, and the base processor is adapted to perform the functionality of, a first subset of a network layer of the communication protocol stack, and wherein the base processor does not perform the functionality of a second subset of the network layer, instead allowing the communication module to perform the functionality of the second subset of the network layer (see section [0016]).

Regarding claim 34, Dowling teaches a communication module for use in a portable terminal utilizing a communication protocol stack having higher and lower layers, the portable terminal also comprising a base module adapted to perform the functionality of the higher layers of the communication protocol stack, the communication module comprising: a wireless transceiver (see figs. 1-4); a module memory adapted to store

the lower layers of the communication protocol stack (see figs. 1-4; sections [0016,0057]); and a module processor adapted to cooperate with the base module to effect wireless communication by the wireless transceiver, the module processor being adapted to perform the functionality of the lower layers of the communication protocol stack stored in the module memory (see figs. 1-4; sections [0016,0057]).

Regarding claim 35, the claim includes the limitations as that of claim 23, and therefore is interpreted and rejected fort the same reason set forth in the rejection of claim 23.

Regarding claim 36, the claim includes the limitations as that of claim 24, and therefore is interpreted and rejected fort the same reason set forth in the rejection of claim 24.

Regarding claim 37, the claim includes the limitations as that of claim 25, and therefore is interpreted and rejected fort the same reason set forth in the rejection of claim 25.

Regarding claim 38, the claim includes the limitations as that of claim 26, and therefore is interpreted and rejected fort the same reason set forth in the rejection of claim 26.

Regarding claim 39, Dowling teaches the communication module of claim 34 wherein the lower layers of the communication protocol stack comprise support for roaming (see section [0051,0056]).

Regarding claim 40, Dowling teaches the communication module of claim 34, wherein the lower layers of the communication protocol stack support reliable transmission (see section [0051,0056]).

Regarding claim 41, Dowling teaches the communication module of claim 34, wherein the lower layers of the communication protocol stack comprise a data link layer (see fig. 3).

Regarding claim 42, Dowling teaches the communication module of claim 34, wherein the lower layers of the communication protocol stack comprise a physical layer (see fig. 3).

Regarding claim 43, Dowling teaches the communication module of claim 34, wherein the lower layers of the communication protocol stack comprise at least a portion of a network layer (see fig. 3).

Regarding claim 44, Dowling teaches the communication module of claim 34 wherein the module processor does riot perform at least one higher layer function of the communication protocol stack, instead allowing the base module to perform said at least one higher layer function of the communication protocol stack (see section [0016]).

Regarding claim 45, Dowling teaches the communication module of claim 44, wherein the module processor does not perform the functionality of a sessions layer of the communication protocol stack, instead allowing the base module to perform the functionality of the sessions layer (see sections [0016, 0059]).

Regarding claim 46, Dowling teaches the communication module of claim 44, wherein the module processor does not perform the functionality of a transport layer of the communication protocol stack, instead allowing the base module to perform the functionality of the transport layer (see sections [0016,0059]).

Regarding claim 47, the claim includes the limitations as that of claim 33, and therefore is interpreted and rejected fort the same reason set forth in the rejection of claim 33.

Regarding claim 48, Dowling teaches a portable terminal utilizing a communication protocol stack having higher and lower layers, the portable terminal comprising: a base module comprising a base processor and a base memory, the base memory storing the higher layers of the communication protocol stack for use by the base processor; a communication module comprising a module processor, a module memory, and a wireless transceiver (see figs. 2-5; sections [0016,0046,0057]); the module memory storing the lower layers of the communication protocol stack for use by the module processor in communicating with both the base module and the wireless transceiver (see figs. 2-5; sections [0016,0057]); and the base module receiving the communication

module in an assembled position which communicatively couples the base processor and module processor (see figs. 2-5; sections [0016,0046,0057]).

Regarding claim 49, Dowling teaches the portable terminal of claim 48 wherein the module processor, using the lower layers of the communication protocol stack, enables the base processor, using the higher layers of the communication protocol stack, to communicate with the wireless transceiver regardless of which of a plurality of communication modules is selected (see figs. 2-5; sections [0016]).

Regarding claim 50, the claim includes the limitations as that of claim 24, and therefore is interpreted and rejected fort the same reason set forth in the rejection of claim 24.

Regarding claim 51, the claim includes the limitations as that of claim 25, and therefore is interpreted and rejected fort the same reason set forth in the rejection of claim 25.

Regarding claim 52, the claim includes the limitations as that of claim 37, and therefore is interpreted and rejected fort the same reason set forth in the rejection of claim 37.

Regarding claim 53, the claim includes the limitations as that of claim 38, and therefore is interpreted and rejected fort the same reason set forth in the rejection of claim 38.

Regarding claim 54, the claim includes the limitations as that of claim 39, and therefore is interpreted and rejected fort the same reason set forth in the rejection of claim 39.

Regarding claim 55, the claim includes the limitations as that of claim 40, and therefore is interpreted and rejected fort the same reason set forth in the rejection of claim 40.

Regarding claim 56, the claim includes the limitations as that of claim 41, and therefore is interpreted and rejected fort the same reason set forth in the rejection of claim 41.

Regarding claim 57, the claim includes the limitations as that of claim 43, and therefore is interpreted and rejected fort the same reason set forth in the rejection of claim 43.

Regarding claim 58, Dowling teaches a portable terminal utilizing a communication protocol stack having a highest layer, at least one middle layer and a lowest layer, the portable terminal comprising: a base module comprising a base processor and a base memory, the base memory storing a first set of instructions comprising at least the highest layer of the communication protocol stack (see figs. 2-5; sections [0016,0046,0057]); a communication module comprising a module processor, a module memory, and a wireless transceiver; the wireless transceiver having a second set of instructions comprising at least the lowest layer of the communication protocol stack; the module memory storing the second set of instructions; the module processor using the second set of instructions in communicating with both the wireless transceiver and

the base module; and the base processor using the first set of instructions in communicating with the module processor (see figs. 2-5; sections [0016,0046,0057]).

Regarding claim 59, the claim includes the limitations as that of claim 23, and therefore is interpreted and rejected fort the same reason set forth in the rejection of claim 23.

Regarding claim 60, the claim includes the limitations as that of claim 24, and therefore is interpreted and rejected fort the same reason set forth in the rejection of claim 24.

Regarding claim 57, the claim includes the limitations as that of claim 43, and therefore is interpreted and rejected fort the same reason set forth in the rejection of claim 43.

Regarding claim 61, Dowling teaches the portable terminal of claim 58 wherein the second set of instructions comprises at least a portion of the at least one middle layer of the communication protocol stack (see fig. 3).

Regarding claim 62, the claim includes the limitations as that of claim 37, and therefore is interpreted and rejected fort the same reason set forth in the rejection of claim 37.

Regarding claim 63, the claim includes the limitations as that of claim 38, and therefore is interpreted and rejected fort the same reason set forth in the rejection of claim 38.

Regarding claim 64, the claim includes the limitations as that of claim 39, and therefore is interpreted and rejected fort the same reason set forth in the rejection of claim 39.

Regarding claim 65, the claim includes the limitations as that of claim 40, and therefore is interpreted and rejected fort the same reason set forth in the rejection of claim 40.

Regarding claim 66, the claim includes the limitations as that of claim 41, and therefore is interpreted and rejected fort the same reason set forth in the rejection of claim 41.

Regarding claim 67, the claim includes the limitations as that of claim 43, and therefore is interpreted and rejected fort the same reason set forth in the rejection of claim 43.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MINH D. DAO whose telephone number is 571-272-7851. The examiner can normally be reached on 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MATTHEW ANDERSON can be reached on 571-272-4177. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Minh Dao
AU 2618
September 12, 2006

Matthew Anderson
Superviser AU 2618